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In re Application of :
Grant HAY et al :
Application No. 10/787,158 : DECISION ON PETITION
Filed: February 27, 2004 : UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 040849-0256 :

This is a decision on the petition under 37 CFR 1.78(a)(6), filed May 1, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 119 for the benefit of priority to prior-filed provisional Application No. 60/451,342, filed February 28, 2003.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119 and 37 CFR 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition requests that the application data sheet (ADS) filed with the application on February 27, 2004 be amended to reflect that this application is claiming benefit of priority to provisional Application No. 60/451,342 rather than to 60/451,632, the application now appearing on the ADS. However, the manner of making this amendment is improper and therefore unacceptable as a proper reference under 37 CFR 1.78(a)(5)(i). In this regard, the amendment is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 provides that the claim (in this case, the claim for priority) must commence on a separate physical sheet.

The rule at 37 CFR 1.4(c) provides that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

Before the petition can be granted, petitioner must submit a proper amendment in compliance with the aforementioned rules by either submitting an amendment to the first line of the specification following the title or by submitting a supplemental ADS, along with a renewed petition under 37 CFR 1.78(a)(6).


Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.


Frances Hicks
Petitions Examiner
Office of Petitions